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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,791	10/06/2003	Lawrence J. DeAngelis		3726

7590 12/27/2006
LAWRENCE J. DeANGELIS
124 LOTUS STREET
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EXAMINER

SHEIKH, ASFAND M

ART UNIT	PAPER NUMBER
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3627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/679,791	DEANGELIS, LAWRENCE J.	
	Examiner	Art Unit	
	Asfand M. Sheikh	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 01 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to the Remarks/Arguments received on 01-Nov-2006:
claims 31-42 have been newly added and are pending for
examination. Claims 1-30 have been cancelled.

In light of the newly added claims, new grounds of rejection
have been established. This action has been made **FINAL**.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35
U.S.C. 112:

The specification shall conclude with one or more claims particularly
pointing out and distinctly claiming the subject matter which the applicant
regards as his invention.

2. Claim 31-42 rejected under 35 U.S.C. 112, second paragraph,
as being indefinite for failing to particularly point out and
distinctly claim the subject matter which applicant regards as
the invention.

As per claims 31-42, The Examiner notes claims 31-42 are
rejected as failing to define the invention in the manner
required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with
indefinite and functional or operational language. The

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structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

As per claim 31-42, The Examiner notes that claims 31-42 make reference to multiple statutory classes of invention (e.g. method and system). A claim that purports to be within multiple statutory classes is ambiguous and is properly rejected under U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the invention (see Ex Parte Lyell).

As per claims 31-42, the Examiner notes that there is insufficient antecedent found through out claims 32-34; appropriate action is required.

As per claim 34, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 31-35 are rejected under 35 U.S.C. 101 because the claims fail to produce a tangible result.

As per claim 31-35, In order for claimed subject matter to be considered patent eligible under 35 U.S.C. 101 it must contain a tangible result. The focus of this determination is on the result of the claim as a whole, not the individual steps or structure used to produce the result. Further to be tangible the process claim must set forth a practical application thereby producing a real-world result. It is the position of the Examiner that the impartial electronic matchmaking method that introduces buyers to sellers of products and services does not produce a tangible (real-world) result. The claims recite matching buyers to sellers. There is no step that generates an actual result. Therefore the claims 31-35 are found to be directed towards subject matter, which is not patent eligible under 35 U.S.C. 101.

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 31, 32, 34, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al. United States Patent 5,664,110 (hereinafter Green) in view of Owens United States Patent Application Publication 2003/0004831.

As per claim 31, Green discloses an impartial electronic matchmaking method that introduces buyers to sellers of products and services that can be identified by barcode or RFID tag numbers in the form of individual digital merchandise codes (IDMC) (see at least, ABSTRACT and col. 3, lines 5-21), where the nucleus of the system resides on a server, referred to as the Shopper Assistant Portal (SAP) (see at least, col. 2, lines 52-62), working in conjunction any terminal-device, with the users of the terminal device being referred to as Shoppers (see

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at least, col. 2, lines 52-62 and col. 4, lines 22-26 and lines 36-39),

Green fails to explicitly disclose a software application that resided on a server attached to the Internet, a software application that can be compiled to be run on any terminal-device that is capable of accessing the Internet, directly or indirectly, and software that resides on servers that are also connected to the Internet belonging to individual Merchants of products and/or services.

However Owens discloses a software application that resided on a server attached to the Internet (see at least, 0191-0203 and FIG(s). 1-4), a software application that can be compiled to be run on any terminal-device that is capable of accessing the Internet, directly or indirectly (see at least, 0191-0203 and FIG(s). 1-4), and software that resides on servers that are also connected to the Internet belonging to individual Merchants of products and/or services (see at least, 0191-0203 and FIG(s). 1-4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Green to include a software application that resided on a server attached to the Internet, a software application that can be compiled to be run on any terminal-device that is capable of

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accessing the Internet, directly or indirectly, and software that resides on servers that are also connected to the Internet belonging to individual Merchants of products and/or services as taught by Owens. One of ordinary skill in the art would have been motivated to combine the teachings in order to allow for a new and effective method and system for interactively shopping for product and/or services on the Internet (Owens, see at least, 0013).

As per claim 32, Green fails to explicitly disclose wherein the shoppers are registered users who choose the geographical area they want to shop in.

However Owens discloses wherein the shoppers are registered users who choose the geographical area they want to shop in (see at least, 0218).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Green to include wherein the shoppers are registered users who choose the geographical area they want to shop in as taught by Owens. The motivation to combine is the same as claim 31, above.

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As per claim 34, Green discloses electronically collecting into memory storage on or a plurality of IDMC numbers, in one or sever sessions, that are saved into a database utilizing a scanning barcode symbol with any capable barcode scanner and where multiple collections of the same ID would increment the Quantity field instead of creating a new record (see at least, col. 7, lines 65-67 and col. 8, lines 1-14).

As per claim 35, Green discloses electronically connecting the terminal-device to the Shopper Assistant Portal (see at least, col. 4, lines 61-67)

Green fails to explicitly disclose the Shopping Assistant Portal maintaining information relating to all products and/or services, and IDMC of products and/or Services offered by the plurality of Merchants.

However Owens discloses the e\Shopping Assistant Portal maintaining information relating to all products and/or services, and IDMC of products and/or Services offered by the plurality of Merchants (see at least, FIG. 4; "409; Store Item Inventory and Promotions")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Green to include the Shopping Assistant Portal maintaining

information relating to all products and/or services, and IDMC of products and/or Services offered by the plurality of Merchants as taught by Owens. The motivation to combine is the same as claim 31, above.

As per claim 36, Green discloses establishing an Active List by said Shipper selecting and uploading one of the possible pluralities of IDMC databases of desired products and/or services from the terminal-device to the Shopper Assistant Portal, where the Shopper assistant Portal processes the said Active-List by matching each record in the said Active-List with the associated data of each product or service thereby updating the said Active-List with the current Data that consist of at least the basic description and downloading the updated version of the said Active-List to the terminal device to examined and possibly modified by the said Shopper (see at least, col. 8, lines 35-49 and col. 9, lines 23-34).

5. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al. United States Patent 5,664,110 (hereinafter Green) in view of Owens United States Patent Application Publication 2003/0004831 as applied to claim ³¹~~26~~

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above, and further in view of Segal United States Patent Application Publication 2001/0032093 (hereinafter Segal).

As per claim 33, Green discloses merchants are registered members (see at least, col. 5, lined 22-24).

The combination method of Green and Owens fails to explicitly disclose wherein the Merchants choose the geographic area they want to shop in.

However Segal discloses wherein the Merchants choose the geographic area they want to shop in (see at least, 0035).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination method of Green and Owens to include wherein the Merchants choose the geographic area they want to shop in as taught by Segal. One of ordinary skill in the art would have been motivated to combine the teachings in order to allow vendor to target a given area and expend the necessities required in order promote business and sales for that given target area.

6. Claims 37-39 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al. United States Patent 5,664,110 (hereinafter Green) in view of Owens United States Patent Application Publication 2003/0004831 as applied to claim

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*F.2
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³¹
~~36~~ above, and further in view of Miller et al. United States Patent Application Publication 2001/0054008 (hereinafter Miller).

As per claim 37, Green discloses uploading said Active-List to the Shopper Assistant Portal, wherein the Shopper Assistant Portal matches products and/or services to one Merchant (see at least, col. 8, lines 35-49 and col. 9, lines 23-34).

Green fails to explicitly disclose where software on the Shopper Assistant Portal processes the said Active-List by matching each record in the said Active-List wherein the Quantity field is greater than zero, with Merchants that offer the products or services that cater to the area determined by the said Shopper, creating a database file that contains every Merchant that caters to the said Shopper's specified area and offer one or more of the products and/or services in the said Active-List, where the said database file is referred to as a List of Merchant, then downloading the said list of Merchant to the terminal-device from the Shopper Assistant Portal and displaying at least the name of one Merchant in the said List of Merchant on the terminal-device to be examined by the said shopper.

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However Owens discloses software that Merchants that offer the products or services that cater-to the area determined by the said Shopper, creating a file that contains every Merchant that caters to the said Shopper's specified area and offer one or more of the products and/or services, where the said file is referred to as a List of Merchant, then downloading the said list of Merchant to the terminal-device to be examined by the said shopper (see at least, 0208, 0218, 0226, 0233, and 0239).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Green to include software that Merchants that that offer the products or services that cater-to the area determined by the said Shopper, creating a file that contains every Merchant that caters to the said Shopper's specified area and offer one or more of the products and/or services, where the said file is referred to as a List of Merchant, then downloading the said list of Merchant to the terminal-device to be examined by the said shopper as taught by Owens. The motivation to combine is the same as claim 31, above.

The combination method of Green and Owens fails to explicitly disclose matching each record in the said Active-List wherein the Quantity field is greater than zero.

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Miller discloses matching customers to merchants that have product in stock whose Quantity is greater than zero because (see at least, 0178).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination method of Green and Owens to include matching customers to merchants that have product in stock whose Quantity is greater than zero as taught by Miller. One of ordinary skill in the art would have been motivated to combine the teachings in order to allow a customer to purchase a product without worrying if the product is in stock.

As per claim 38, Green discloses selecting a Merchant from a list of Merchants via the terminal device (see at least, col. 5, lines 28-32).

Green fails to explicitly disclose initiating software on the said Shopper's terminal-device, that notifies the Shopper Assistant Portal of the said Shopper's selection, where the software on the Shoppers Assistant Portal of the said Shopper's selection, where the Shopper Assistant portal processes the said Shopper's request by generating a data-package that includes among other data, the said Active-List then electronically redirects the said shopper and the said data-package, to a URL

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(Uniform Resource Locator) that has been specified by the selected merchant.

However Owens discloses processing a data-package that includes the said Active-List then electronically redirecting the said shopper and said data-package, to a URL that has been specified by the selected Merchant (see at least, 0228).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Green to include processing a data-package that includes the said Active-List then electronically redirecting the said shopper and said data-package, to a URL that has been specified by the selected Merchant as taught by Owens. The motivation to combine is the same as claim 31, above.

As per claim 39, Green fails to explicitly disclose said selected merchant server, processes the said data-package and establishes a session with the said Shopper, whereby the said Shopper interacts directly with said Merchant through a user interface designed and maintained by said Merchant, whereby the said Shopper may purchase or order one or more of the product and/or services from the said Merchant utilizing a point-of-sale system specified by the Merchant.

However Owens discloses whereby the said Shopper interacts directly with said Merchant through a user interface designed and maintained by said Merchant, placing an order one or more products and/or services from the said Merchant utilizing a point-of-sale system specified by the said merchant (see at least, 0228).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Green to include whereby the said Shopper interacts directly with said Merchant through a user interface designed and maintained by said Merchant, placing an order one or more products and/or services from the said Merchant utilizing a point-of-sale system specified by the said merchant as taught by Owens. The motivation to combine is the same as claim 31, above.

As per claim 42, Green discloses wherein Shopper Assistant Portal saves a copy of the said Active-List distinctly for each merchant that the said Shopper is in session with (see at least, col. 13, lines 9-27)

7. Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al. United States Patent

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5,664,110 (hereinafter Green) in view of Owens United States Patent Application Publication 2003/0004831 and further in view of Miller et al. United States Patent Application Publication 2001/0054008 (hereinafter Miller) as applied to claim 39 above, and further in view of Chu et al. United States Patent Application Publication 2002/0174021.

As per claim 40, the combination method of Green, Owens, and Miller disclose and Active-List built on a terminal-device, which is sent electronically to a Shoppers Assistant Portal, which is then sent electronically to the Merchant site (see at least, claim 39 rejection).

The combination method of Green, Owens, and Miller all fail to explicitly disclose upon the termination of the said session between the said Shopper and the said Merchant, software on the said Merchant's server modifies the said Active-List by adjusting the Quantity field(s) in accordance with the said session, then electronically sends a data-package that includes among other data, the said modified Active-List, to the Shopper Assistant Portal, where the said Active-List is processed on the Shopper Assistant Portal to determine if there are any records where the Quantity field is greater than zero.

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However Chu discloses processing the Active-List on the Shopper Assistant Portal to determine if which items were unavailable and revising the shopping list (see at least, 0014).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination system of Green, Owens, and Miller to include processing a data-package that includes the said Active-List then electronically redirecting the said shopper and said data-package, to a URL that has been specified by the selected Merchant as taught by Chu. One of ordinary skill in the art would have been motivated to combine the teachings in order to provide an automated technique for optimizing a user's shopping experience (Chu, see at least, 0017).

As per claim 41, The Examiner notes that the limitations of claim 41 are substantially similar to that of claim 37, and thus are rejected under similar grounds. Further, the Examiner notes Green shows the function to Quit (see at least, FIG. 9).

Response to Arguments

8. Applicant's arguments with respect to claims 31-42 have been considered but are moot in view of the new ground(s) of

rejection and further the arguments filed have been fully considered but they are not persuasive.

With respect to Applicant's Arguments directed to claiming benefit to earlier filing data and cross-reference to other applications, the Examiner notes that current pending application cannot claim benefit to United States Patent 4,654,482 seeing that the given application was not filed during the prosecution of the '482 Patent. Therefore, no continuation can be claimed to the '482 Patent.

With respect to Applicants Arguments directed to 35 U.S.C. 101, the Examiner has never issued a U.S.C. 101 rejection in the previous action. The Examiner has established a U.S.C. 101 rejection for the newly added claims.

The Examiner notes that Applicant applicants argument towards U.S.C. 101 is directed to the patentability of numerous Patents that infringe on the '482 Patent. The Examiner notes this issue is moot towards the prosecution of the current application. The Examiner has advised the Applicant in numerous telephonic calls that this matter should be discussed with an Attorney.

Examiner's Acknowledgments

9. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450.

10. Examiner further notes, if the Applicant decides to continue self-prosecution, the Examiner urges the Applicant to look over the cited references and utilize them as a basis for claim construction.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asfand M. Sheikh whose telephone number is (571) 272-1466. The examiner can normally be reached on M-F 8a-4:30p.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan M. Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Asfand M Sheikh
Examiner
Art Unit 3627

ams
16-Dec-06



F. RYAN ZEENDER
PRIMARY EXAMINER

12/14/06